

REMARKS

This amendment is filed in response to the Office Action dated December 12, 2007. In view of these amendments and remarks, this application should be allowed and the case passed to issue. No new matter is introduced by this amendment. The amendments to the specification correct informalities.

Claims 1-8 are pending in this application. Claims 1-8 are rejected.

Interview Summary

Applicants gratefully acknowledge the courtesy of Examiner Burney in granting telephone interviews with the undersigned. On April 2, 2008, the undersigned called Examiner Burney and explained that there was no teaching of a glycidyl ester of a tertiary fatty acid in the section of Asami et al. cited by the Examiner. The undersigned requested clarification on whether and where Asami et al. teach glycidyl esters of a tertiary fatty acid. The Examiner indicated she would review Asami et al. and call back. On April 3, 2008, Examiner Burney acknowledged that Asami et al. does not appear to disclose a glycidyl ester of a tertiary fatty acid, and indicated that Applicants arguments would be given further consideration when presented in a written response.

Objections to the Drawings

The drawings were objected to as failing to comply with 37 C.F.R. § 1.84(p)(5) because the reference characters 6 and A are not disclosed in the specification. This objection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The specification has been amended to include Reference No. 6 and Fig. 1 has been amended to delete Reference Character A. Amended Fig. 1 is attached as a Replacement Sheet.

Amendments to the Drawings:

Fig. 1 is amended to delete reference character A. The amended Fig. 1 is attached to this response and is labeled Replacement Sheet.

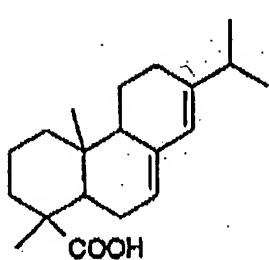
Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumura et al. (US 4,968,575) in view of Asami et al. (US 6,447,973). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the present invention, as claimed, and the cited prior art.

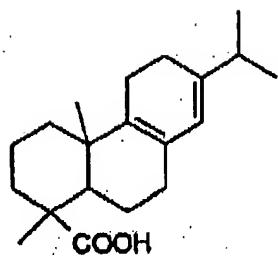
The Examiner asserted that Matsumura et al. disclose a polyester comprising a disproportionated rosin, terephthalic acid, glycol, and an aliphatic diol in the claimed ratios. The Examiner acknowledged that Matsumura et al. do not disclose a glycidyl ester of a tertiary fatty acid as part of the alcohol component. The Examiner relied on the teaching of Asami et al. to conclude that it would have been obvious to include a rosin glycidyl ester in the composition of Matsumura et al.

The combination of Matsumura et al. and Asami et al. do not suggest the claimed polyester resin for toner because neither Matsumura et al. nor Asami et al. suggest a glycidyl ester of tertiary fatty acid, as required by claim 1.

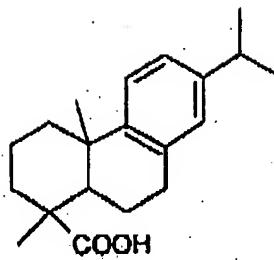
Asami et al. disclose a rosin glycidyl ester. A rosin glycidyl ester, however, does not correspond to a glycidyl ester of a tertiary fatty acid. The main component of rosin is an abietic acid, as shown below. Modified rosin may comprise, as the main component, parastrinic acid, dehydroabietic acid, neoabietic acid, pimaric acid, isopimaric acid or the like, as shown below.



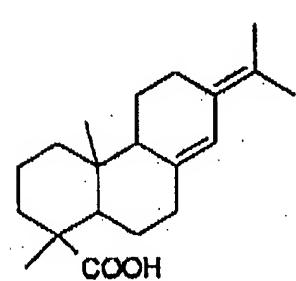
Abietic acid



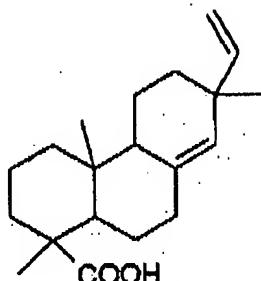
parastrinic acid



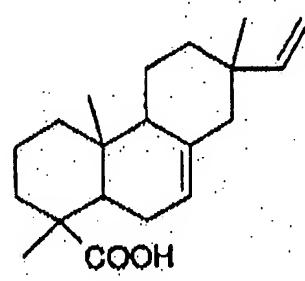
dehydroabietic acid



neoabietic acid

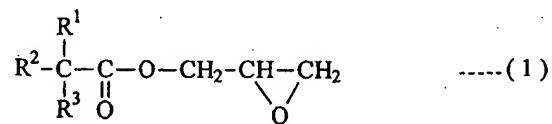


pimamic acid



isopimamic acid

As is apparent from the above formulae, rosin comprises compounds wherein a carboxyl group as a substituent is bound to a cycloalkane, and thus do not correspond to fatty acids. Glycidyl esters of tertiary fatty acids are compounds wherein alkyl groups are bound to a tertiary carbon, as represented by formula (1) below, and as taught on page 13 of the present specification.



wherein R^1 , R^2 and R^3 each represents an alkyl group. Accordingly, Asami et al. do not disclose the glycidyl ester of a tertiary fatty acid.

Though the present invention, according to claim 2, requires a rosin glycidyl ester. The rosin glycidyl ester is in addition to the glycidyl ester of a tertiary fatty acid required by claim 1.

It would be further unobvious to combine Asami et al. with Matsumura et al., as asserted by the Examiner, because Asami et al. disclose a liquid developer. The liquid developer and the dry developer of the Matsumura et al. and the present invention have completely different properties. Accordingly, it would not be obvious to those skilled in the art to use a rosin glycidyl ester as one of resin components of a dry developer, even though Asami et al. exemplify a rosin glycidyl ester as one of resin components in a liquid developer.

The use of the polyester resin according to the present invention ensures long-term good development in any environment and solves environmental problems caused by bisphenol A, as explained in the present specification. Additionally, the elimination of bisphenol A as an alcohol component provides unexpected and remarkable advantages in the reduction in true density of the resin and reduces the amount by weight of toners consumed.

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no suggestion in Matsumura et al. and Asami et al. to modify toner resin of Matsumura et al. to include an alcohol component comprising a glycidyl ester of tertiary fatty acid, as required by claim 1, nor does common sense dictate the Examiner-asserted modification. The Examiner has not provided any evidence that there would be any

obvious benefit in making the asserted modification of Matsumura et al. See *KSR Int'l Co. v. Teleflex, Inc.*, 500 U.S. ____ (No. 04-1350, April 30, 2007) at 20.

The only teaching of a polyester resin for toner wherein an alcohol component of the polyester resin comprises glycidyl ester of tertiary fatty acid is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must not be based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumura et al. in view of Asami et al. and further in view of Murata et al. (US 2002/0085851). Murata et al. is relied on for the teaching of a fixing belt.

Claim 8 is allowable for at least the same reasons as claim 1. Murata et al. do not cure the deficiencies of Matsumura et al. and Asami et al. because Murata et al. do not suggest the glycidyl ester of a tertiary fatty acid, as required by claim 1.

The dependent claims are allowable for at least the same reasons as claim 1, and further distinguish the claimed toner and method. For example, claim 6 further requires a salt of aromatic hydrocarboxylic acid. The Examiner averred that Bontron S taught by Matsumura et al. is a salt of aromatic hydrocarboxylic acid. However, as shown in the attached catalogue page, Bontron S is a azochromium complex, not a salt of aromatic hydrocarboxylic acid.

In view of the above amendments and remarks, Applicants submit that this case should be allowed and passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Bernard P. Codd
Bernard P. Codd
Registration No. 46,429

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BPC:kap
Facsimile: 202.756.8087
Date: April 10, 2008

**Please recognize our Customer No. 20277
as our correspondence address.**